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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,420	09/13/2003	Walter E. Pipo	PipoW_P_1_03	8103
34442	7590	09/22/2005	EXAMINER	
PATRICIA M. COSTANZO PATENT COPYRIGHT TRADEMARK LAW 2960 BOWEN ROAD ELMA, NY 14059			CARIASO, ALAN B	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,420

Applicant(s)

PIPO ET AL.

Examiner

Alan Cariaso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Receipt of applicant's amendment filed July 21, 2005 is acknowledged. Claims 1-20 are a pending. Claims 4, 5, 19 and 20 are amended.

Claim Objections

2. Claims 12-20 are objected to because of the following informalities:
3. In each of claims 12-20, line 1, they each incorrectly recite "Claim 1" to the right of the paragraph number (i.e. 12, 13 ...20) which appears would be the correct claim number, if place to the right of "Claim" while delete "1".
4. Claim 19, line 11, "a second end" (of said fiber) is incorrectly addressed and should instead be --said second end-- because the limitation "a second end" of said fiber already has antecedent basis on line 7.
5. Appropriate correction is required.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 5-7, 13-16, 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 13-16 and 18-20 of copending Application No. 10/736,468. Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1, 19 and 20, of application 10/736,468, the claimed self-illuminating fabricated solid object assembly of 10/661,420 application (indicated in parenthesis) comprises at least one visually exposed surface (at least one visually exposed surface '420 claim 1), at least one aperture (ditto), said aperture opening on an accessible surface (at least one aperture open to an outer surface), at least one optical fiber (ditto) positioned within said solid object (embedded within said fabricated solid object), a first end of said optical fiber visually terminating at said visually exposed surface of said solid object (said first end of said fiber arranged to terminate at said at least one visually exposed surface of said fabricated solid object), a second end of said optical fiber operatively related to said aperture to receive light (said second end of said receptacle operatively coupled with said aperture, said second end of said receptacle adapted to reversibly receive said light source providing for operative contact of said light source with said second end of said fiber), whereby light emitted from an exchangeable light source means is transmitted to said visually exposed surface of said solid object by said optical fiber (at least one reversibly powered light source with said second end of said receptacle ... whereby light is emitted from said visually exposed surface of said

fabricated object); claim 2, further comprising at least one receptacle operatively relating to said at least one aperture, said receptacle receiving said second end of said optical fiber providing for said second end of said optical fiber to receive light (at least one receptacle embedded within said solid object, said receptacle having at least a first and a second end, said first end of said receptacle adapted to encompass said second end of said at least one optical fiber, said second end of said receptacle operatively coupled with said aperture; '420 claim 1); claim 3, further comprising said at least one receptacle receiving an exchangeable light source providing for transmission of light from said exchangeable light source to said first end of said optical fiber visually terminating at said at least one visually exposed surface of said solid object (at least one reversibly powered light source with said second end of said receptacle ... whereby light is emitted from said visually exposed surface of said fabricated object, '420 claim 1); claim 4 (ditto claim 2); claim 5, said any known solidification means includes any known molding means (said any known solidification means includes molding techniques, '420 claim 5); claim 6 (claim 6); claim 7 (claim 7); claims 13-16 & 18 (claims 13-16 & 18 of '420).

8. Furthermore claims 3 and 4 are also provisionally rejected as being depending on base claim(s) above, reciting setting techniques and pressing techniques regarding the solidification means. Please note that the method of forming the device is not germane to the issue of patentability of the device itself. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or

obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these (i.e. method) limitations have not been given patentable weight.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 8-12, 17, 18 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 13-16 and 18-20 of copending Application No. 10/736,468 in view of ROBB (5,619,182). Claims 8-12 recite plural patterns, unique colored light, patterns comprise seasonal designs, informational messages, advertising, a transparent object and light emitting diode. ROBB teaches embedded lighting systems that include plural patterns (16, 18, fig.2) that indicate specific operations, unique colored light using lighting diodes (40, 30) for indicating condition or messages and a transparent object (10) for allowing external visibility of lighted patterns of the assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the claimed self-illuminating object assembly of the present application to include at least the type of plural, colored, indicating lights with lighting diodes and transparent object as taught by ROBB in order to visually indicate plural operations being performed using different colored LEDs that respond to the functioning operation.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by HARRISON (US 4,754,372).

12. HARRISON discloses a method for illuminating an object assembly, comprising the steps of: providing for at least one object (10d,11 in fig.2) to be illuminated; providing for at least one aperture (17, fig.5) in said at least one object (10d,11,16) to be illuminated; providing for at least one light source (31, fig.4); providing for at least one optical fiber (13) functionally embedded (fig.7) within said object (14,15,16), said fiber (13) having a first end (18) and a second end (36, fig.4) said first end (18) of said fiber (13) arranged to terminate at an at least one visually exposed surface (14, col.3, lines 55-68) of said object (10d,11); and reversibly inserting (col.3, lines 46-48) said at least one light source (31, 32) within said at least one aperture (17), said light source (31) providing illumination to a/said second end (36, fig.4) of said fiber (13) enabling light emitted from said light source (31) to be guided from said light source (31) through said fiber (13), wherein light is emitted from said visually exposed surface (14) of said object assembly.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over HARRISON (US 4,754,372) in view of SHIH (US 6,234,657).

15. HARRISON discloses the claimed invention, including at least one receiving means (32) embedded within said solid object (col.3, lines 43-50) and operatively coupled with said aperture (17), said receiving means (32) adapted for encompassing (col.3, lines 36-40) another end (36) of said at least one optical fiber (13), wherein said receiving means (32), wherein said receiving means (32) adapted to reversibly receive said light source means (31, fig.4) providing for operative contact of said light source means (31). However, HARRISON does not disclose at least one light emitting diode light source means.

16. SHIH teaches the use of at least one light emitting diode (50") as light source means (fig.9) received in a receiving means (40") holding ends (22b") of optical fibers (22") for the purpose of enabling light of pure color (col.4, lines 15-28) from the LED (50") to be guided to the display end (22a") onto the apertures of the display surface (1"). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the illumination display device of HARRISON to include

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the type of light emitting diode light source means as taught by SHIH in order to display a pure colored light pattern on the exposed surface of the display with simplified light source placement and construction, without complicated construction using movable color wheels or filters.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (571) 272-2366. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alan Cariaso
Primary Examiner
Art Unit 2875

September 19, 2005
AC